

10/604,017  
Attorney Docket No. 71-001

### Remarks

#### Specification

Paragraphs 33 and 39 have been amended to reflect that the shield superior border may also be located below the occlusal table as is clearly shown in Figure 6.

#### Claim Rejections – 35 USC § 112

The examiner has rejected claims 1-26 for insufficient antecedent basis for the limitation "the transverse member inferior border". Independent claims 1 and 24, as amended, from which claims 2-23 and 25, respectively, depend now provide sufficient antecedent basis. Support for these amendments can be found, for example in paragraph 38. These amendments have been made not for reasons relating to patentability, but rather, to correct improper wording of the claims.

Claim 26 has been cancelled.

#### Claim Rejections – 35 USC § 102

The office action does not specifically address claim 12. The examiner's comments to claim 11 are apparently directed to claim 12. In a telephone conversation with the examiner, the undersigned was told the comments directed to claim 11 apply to both claims 11 and 12.

The examiner has rejected claims 1, 2, 4, 7-13, 18-21, 23, 24 and 26 as being anticipated by Milano. Applicant respectfully disagrees.

Milano's tongue element 18 is not a shield, but rather, a "tongue engaging

10/604,017  
Attorney Docket No. 71-001

element" (Milano, column 3, line 1). As evidenced by figure 4, it actively keeps the tongue from the operative site by pressing upon it. Milano column 3, lines 15-19 reads "the tongue-engaging element 18 engages the tongue 22 so as to remove these parts of the mouth from close proximity to the tooth 23." (emphasis added). Unlike Milano which requires the dentist to actively press the tongue away from the operative site, the present invention requires no force to physically remove the tongue. No outward force is directed towards the tongue, rather, the tongue is merely passively shielded from the operative site.

Because independent claims 1 and 24, as amended, are not anticipated by Milano, the dependent claims are also not anticipated.

Claims 1, 7, 9-16, 18-21, and 23-26 are rejected as being anticipated by Hachman. Independent claims 1 and 24 have been amended such that the first shield is substantially flat. Support for this amendment can be found, for example at paragraph 33. Hachman, at page 2, first column, lines 45-48 requires the first shield 19 not be substantially flat, but rather to be "curved outwardly".

Independent claims 1 and 24, as amended and, hence, the dependent claims are not anticipated by Hachman.

#### Claim Rejections – 35 USC § 103

Claim 3 is rejected as unpatentable over Milano in view of Riewenherm. Claims 5 and 6 are rejected as unpatentable over Milano in view of Caswell. Claim 22 is rejected as unpatentable over Milano in view of Hertz. Applicant respectfully disagrees.

10/604,017  
Attorney Docket No. 71-001

As discussed above, Milano teaches away from the present invention, in that it requires active pressure upon the tongue. Since the primary reference teaches away from the present invention, its combination with Riewenherm, Caswell and Hertz is moot.

Claim 17 is rejected as unpatentable over Hachman. Applicant respectfully disagrees. Hachman teaches away from amended claim 1 (from which claim 17 depends) in that it requires an outwardly curved first shield.

#### New Claims

New claim 27 differs from amended claim 1 in that it does not require the limitation of a substantially flat first shield but does require at least one shield superior border to terminate below the occlusal table. As discussed above, support for this limitation can be found, for example, in amended paragraphs 33 and 39, which find their support in Figure 6. The shields of both Milano and Hachman clearly extend above the occlusal table, thereby preventing bite closure.

Support for new claim 28 can be found, for example, in amended paragraphs 33 and 39 and in paragraph 36.

New independent claim 27 which replaces cancelled dependent claim 26 is the third independent claim, so no additional independent claim fee is due. Attached is a credit card authorization form for one additional claim in excess of 20.

#### **Conclusion**

For the foregoing reasons, Applicant respectfully requests the rejections be withdrawn and submits that the application is in condition for allowance. That action is

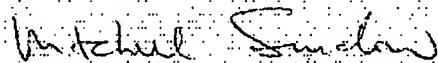
10/604,017  
Attorney Docket No. 71-001

earnestly solicited. If a telephone call is required to expedite this matter, please contact the undersigned.

A credit card authorization form is attached. The Commissioner is hereby authorized to charge any additional fees which may be required or credit any overpayment to Deposit Account No. 502,209.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 502,209.

Respectfully submitted,



Date: 10/04/2004

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10/604,017  
Attorney Docket No. 71-001

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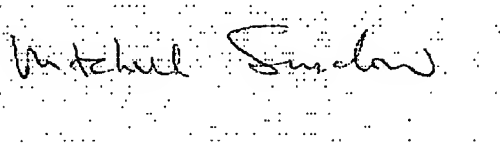
Application No.: 10/604,017	Inventor: Sherry et al.
Filing Date: 06/21/2003	Group Art Unit: 3732
Title: Cheek, Lip and Tongue Shield	Examiner: O'Connor, Cary E.
	Attorney Docket No.: 71-001

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10/604,017  
Attorney Docket No. 71-001

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